

Application No.: 10/828,793
Filing Date.: April 20, 2004

SUMMARY OF INTERVIEW

Attendees, Date and Type of Interview

The interview was conducted on September 18, 2007 and attended by Supervisory Examiner Marjorie Moran and Applicant's representative, John M. Carson.

Exhibits and/or Demonstrations

None

Identification of Claims Discussed

Claims 6 and 19

Identification of Prior Art Discussed

U.S. Patent No. 5,935,060 to Iliff

Proposed Amendments

Applicant discussed proposed amendments.

Principal Arguments and Other Matters

The cited references do not show all the features of the claims proposed.

Results of Interview

The Examiner agreed that Claim 19 describes patentable subject matter, and that the 35 USC §101 and § 112, second paragraph rejections would be overcome when Claims 6 and 19 are combined.

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REMARKS

Claim 6 is amended and Claim 19 is canceled by this paper. Claims 1-5 were previously canceled, and Claims 9, 15 and 22-34 are withdrawn as stated in the Office Action dated June 21, 2007. Claims 7-8, 10-14, 16-18 and 20-21 are unchanged. Claims 6-8, 10-14, 16-18, and 20-21 are under examination in the application. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested.

Examiner Interview

Applicant and Applicant's representative wish to express their sincere appreciation for the availability of Examiner Marjorie Moran to conduct an interview on September 18, 2007, to discuss various matters related to the case. Applicant believes that substantial progress was made as a result of the interview, and believes that this amendment completely addresses the Examiner's concerns expressed therein.

Discussion of Objections to the Specification

The specification is objected to because of informalities. More specifically, the Office Action stated that trademarks are used in the specification and should be capitalized. Applicant has revised the specification at page 89 accordingly.

Discussion of the Rejections under 35 U.S.C. § 101

Claims 6-8, 10-14 and 16-21 are rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Office Action states that because the claims recite software objects, there are both product and process in the same claims.

Applicant has amended Claim 6 by combining it with Claim 19. As discussed at the interview, the amended claim is directed to patentable subject matter, and therefore, there is not both an apparatus and method steps of using the apparatus in the single claim. The Manual of Patent Examining Procedure at 2106.01(I) recites that "When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim." Furthermore, the Manual of Patent Examining Procedure at

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2106(IV) and the USPTO Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility both recite:

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter it belongs in, does not affect the analysis to be performed by the examiner. Note that an apparatus claim with process steps is not classified as a "hybrid" claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., R.A.C.C. Indus. v. Stun-Tech, Inc., 178 F.3d 1309 (Fed. Cir.1998) (unpublished).

Discussion of the Rejections under 35 U.S.C. § 112, ¶2

Claims 6-8, 10-14 and 16-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As above, the Office Action states that a single claim recites both apparatus and a method of using the apparatus.

Applicant has amended Claim 6 by combining it with Claim 19. As discussed above, the amended claim is directed to patentable subject matter, and therefore, there is not both an apparatus and method steps of using the apparatus in the single claim.

Discussion of the Rejection under 35 U.S.C. § 102(e)

Claims 6-8, 10-14 and 16-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by Iliff (U.S. Patent No. 5,935,060).

To Anticipate a Claim, the Reference Must Teach Every Element of the Claim

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

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Analysis

The Iliff reference does not teach every element of the amended independent Claim 6. Applicant's amended Claim 6 recites in pertinent part: "a plurality of objects which interact to determine a diagnosis of a patient, wherein the objects include at least two of: a disease object, a symptom object... wherein each object has corresponding data and processes, and wherein the data is encapsulated so that other objects only see the processes of a particular object that can be invoked to access the data".

The recited feature of "the data is encapsulated so that other objects only see the processes of a particular object that can be invoked to access the data" is discussed in one example as the data being hidden, so that a user of the object only sees the processes that can be invoked (see Applicant's specification at page 11, second sentence of paragraph [0066]). Additionally, in an example, the specification at page 13, paragraph [0072] recites the following:

An important property of an object is that the object's data can be hidden behind the object's processes, so that the outside user of the object can only see and use object processes that can be invoked to access the data. The object is said to "hide" data

In the example discussed at paragraph [0066], the specification recites: "In computer software terms, an object is a combination of data and processes that manipulate the data." In contrast, the disease lists and symptom lists of the Iliff patent cannot hide data from other objects since the disease list is just a list of diseases (data) and the symptom list is a list of symptoms (data), and a list does not explicitly or inherently hide data.

Furthermore, the Office Action appears to be equating the disease lists and the symptom lists of the Iliff patent to the disease objects and symptom objects. In the Iliff patent, the disease, symptom and question lists (shown in Figures 3B and 10) are just data (see Iliff, column 10, lines 37-46 where the disease, symptom and question lists are described). The Iliff patent describes a plurality of disease lists and a plurality of symptom lists, but Iliff does not describe a plurality of disease objects and symptom objects.

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Discussion of the Rejection based on Provisional Double Patenting

Claims 6-8, 10-14 and 16-21 are also provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of Claims 6-10 and 20-42 of U.S. copending Application No. 09/785,044. The claims of the copending application have been amended to be different than the claims in the present application. Note that the Office Action mentions a copending Application No. 10/955,900 which we believe is in error. The claims need to be identical for statutory double patenting, and the claims are not identical.

Furthermore, Claims 6-8, 10-14 and 16-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 6-8, 20-30 and 49-50 of U.S. copending Application No. 09/785,044. Because Claims 6-8, 20-30 and 49-50 of U.S. copending Application No. 09/785,044 have not been allowed, Applicant defers action on this item until the claims of the copending application are allowed.

Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. The dependent claims are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present

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disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Conclusion

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections are specifically requested. Applicant respectfully submits that the claims of the above-identified application are in condition for allowance. However, if the Examiner finds any impediment to allowing all claims that can be resolved by telephone, the Examiner is respectfully requested to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Dated: 11/21/07

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